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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,081	09/15/2005	Peter John Van den Brink	903-122 PCT/US	4510
23869 7590 07/31/2007 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER NGUYEN, SANG H	
			ART UNIT 2886	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,081

Applicant(s)

VAN DEN BRINK ET AL.

Examiner

Sang Nguyen

Art Unit

2886

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-32, 34 and 38-45 is/are rejected.
- 7) ☒ Claim(s) 33 and 35-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/13/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 01/13/05 has been entered. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

Claims 24, 32, and 40-42, and 44 are objected to because of the following informalities:

Regarding claims 24, 32, and 40; the phrase "for example, e.g., or in particular for spectroscopic and microscopic analysis" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 41-42, the recited limitation "the thickness" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 44; the recited term "or" in line 2 is alternative.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2886

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-30, 34, 40, 43, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Wannlund (U.S. Patent No. 5,772,967).

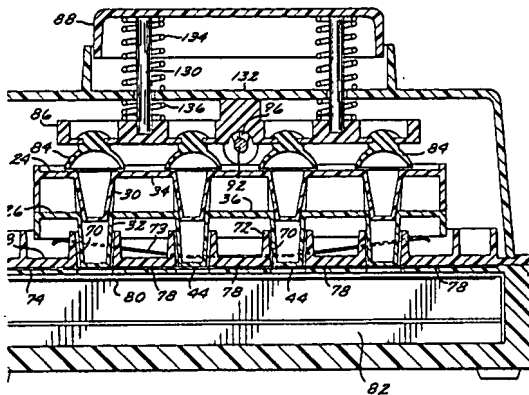
Regarding claims 24, 40, and 45; Wannlund et al discloses a system and a method for the preparation and handling of multiple solid-state samples, said system comprising:

a sample holder assembly (20, 22 of figures 6-10) for multiple solid-state samples (e.g., a plurality of sample wells [28 of figures 1-2]), said sample holder assembly (20, 22 of figure 6) comprising:

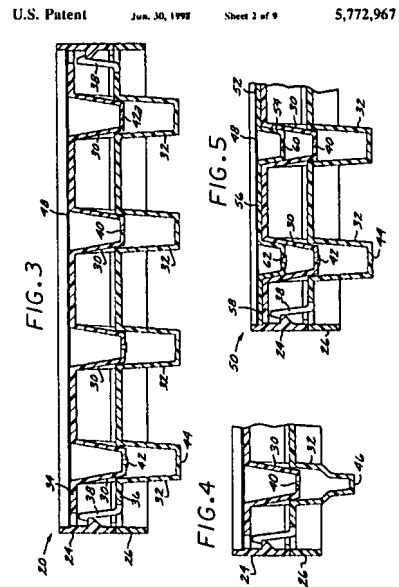
a sample holding body (24 of figures 1-4) having first and second sides (figures 2-4), wherein the sample holding body (24 of figure 2) provided with multiple sample receiving open-ended bores (figures 2-4) extending through said sample holding body (24 of figures 1-4) between said first and second sides (figures 2-4), wherein each bore (figures 2-4) having a first opening (figure 1-4) at the first side (figures 1-4) and a second opening (figure 1-4) at the second side (figure 1-4);

a closure body (66 of figure 7) adapted to be mounted against the second side (figure 7) of the sample holding body (24 of figure 7), said closure body (66 of figure 7) having a closure side (84, 86 of figure 7) adapted to rest against the second side (figure 7) of the sample holding body (24 of figure 7) for closing off the second openings of the bores in said sample holding body (24 of figure 7), and

compacting means (26 of figure 1-7) for compacting samples filled in bores of the sample holding body (24 of figure 1-2 and 7) as these bores are closed off on the second side by the closure side (84, 86 of figure 7) of the closure body (66 of figure 7).



U.S. Patent Jun. 30, 1998 Sheet 4 of 9 5,772,967



It is noted that the process limitations on product claims, which product does not otherwise patentably distinguish over prior art, cannot impact patentability to the product. In re Stephens 145 USPQ 656 (CCPA 1965).

Regarding claim 25; Wannlund et al discloses plugs (42 of figure 3) each adapted to be introduced into a bore via the first opening (figures 3-4).

Regarding claim 26; Wannlund et al discloses plugs (42 of figure 3) are compaction plugs associated with said compaction means (26 of figure 3) for compacting a sample in said bore (figures 1-4).

Art Unit: 2886

Regarding claims 27-28; Wannlund et al discloses plugs (42 of figure 3) are support plugs associated with said sample holding assembly (24 of figure 3), each support plug being adapted to be secured with respect to said bore for supporting a sample in said bore (figures 1-4).

Regarding claim 29; Wannlund et al discloses plugs (42 of figure 3) are slideable in the bores and the compacting means (26 of figure 3) are adapted for pushing the plugs into the bores thereby compacting the samples.

Regarding claim 30; Wannlund et al discloses plugs (42 of figure 7) are diametrically expandable under axial compression by a pressure bar (88 of figure 7) such that the plugs (42 of figure 7) allow for expansion and thereby fixation in said bores (figure 7).

Regarding claims 34; Wannlund et al discloses the second side of the sample holder has a planar surface and wherein the corresponding face of the closure body also has a planar surface.

Regarding claim 43; Wannlund et al discloses the closure body (66 of figure 7) is removed from the second side of the sample holding body (24 of figure 7) thereby exposing the corresponding surface of the samples (figures 3-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

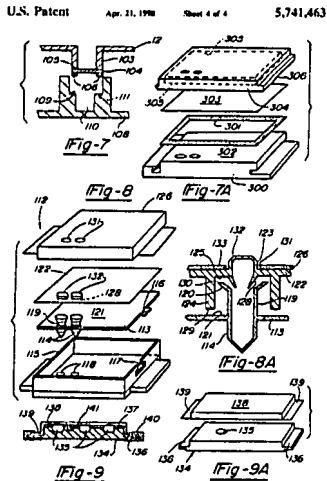
Claims 31-32, 38-39, 41-42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wannund et al (U.S. Patent No. 5,772,967) in view of Sanadi (U.S. Patent No. 5,741,463).

Regarding claim 31; Wannlund et al discloses all of features of claimed invention except for said plugs and bores are screwthreaded . It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine system and method of Wannlund et al with said plugs and bores are screwthreaded, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 19

Regarding claim 32; Wannlund et al discloses all of features of claimed invention except for further comprises securing means for securing a plug in a bore with an adhesive. However, Sanadi teaches that it is known in the art to provide securing means for securing a plug in a bore with an adhesive (106 of figures 7-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine system and method of Wannlund et al with securing means for securing a

Art Unit: 2886

plug in a bore with an adhesive as taught by Sanadi for the purpose of sealing system for glass or plastic slides which can be used without gluing the cover slip to the slide.



Regarding claims 38-39; Wannlund et al discloses all of features of claimed invention except for the bores have a diameter less than 2 cm or the hardness of the closure side of the closure body is greater than 6 Mohs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine system and method of Wannlund et al with the bores have a diameter less than 2 cm or the hardness of the closure side of the closure body is greater than 6 Mohs, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only skill in the art. In re Aller, 105 USPQ 233.

Regarding claims 41-42; Wannlund et al discloses all of features of claimed invention except for the thickness of the compacted samples is at least 100 micrometers. It would have been obvious to one having ordinary skill in the art at the

Art Unit: 2886

time the invention was made to combine system and method of Wannlund et al with the thickness of the compacted samples is at least 100 micrometers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 44; Wannlund et al discloses all of features of claimed invention except for the samples are subjected to a physical or chemical treatment prior to or during the samples to spectroscopic or microscopic analysis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine system and method of Wannlund et al with the samples are subjected to a physical or chemical treatment, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

Claims 33 and 35-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record, taken alone or in combination, fails discloses or render obvious a system for preparation and handling of multiple solid state samples comprising all the specific elements with the specific combination including of the system further comprises plugs each adapted to be introduced into a bore via the first opening, and wherein the compacting means comprise a support removably fixed over

Art Unit: 2886

the first side of the sample holding body, said support having screwthreaded holes aligned with the bores and provided with screws for pushing the plugs into the bores in
set forth limitation of claim 33.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Weinfield et al (7019267); Hall et al (6939516); Warhurt et al (6896848); Hoffman et al (6830732); Madden et al (6783732); or Goodale et al (5356525)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sang Nguyen whose telephone number is (571) 272-2425. The examiner can normally be reached on 9:30 am to 7:00 pm.

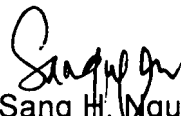
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifu Chowdhury can be reached on (571) 272-2800 ext. 86. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 2886

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 20, 2007


Sang H. Nguyen
Primary Patent Examiner
Art Unit 2886